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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,794	02/08/2002	Lynn Hessing	6331.00014	3675

29747 7590 06/09/2004

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EXAMINER	
MARKS, CHRISTINA M	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/067,794	HESSING ET AL.
	Examiner	Art Unit
	C. Marks	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 February 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08 February 2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method for shuffling must be shown in order to establish the flow of the method, (i.e. a flowchart) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Upon reviewing the specification for its disclosure, it has been determined the term different shuffling requirements is indefinite in that one of ordinary skill in the art would not understand how cards can be shuffled differently. Shuffling is the mixing up of cards and as per the art accepted meaning does not seem to be able to done in a different manner as mixing the cards is mixing the cards regardless of the game being played. Thus the Applicant's limitation that there are different shuffling requirements is indefinite in that a skilled artisan would not be able to ascertain what is meant by this requirement.

Regarding claim 12, it is indefinite in exactly how the image data is collected and used by the system as well as the intent of the claim. The claims seems to attempt combining a

structure and its intended use within a method resulting a number of repeat elements and steps and resulting in an indefinite recitation. For example, the claims recites the limitation that the controller has an image processing means for processing data collected by said image capturing means, but at this point no image capturing has been established. Further, the memory is defined to store images but it has not yet been established that an actual image has been captured. The image capturing does not occur until later in the claim language and further the image capturing means only is defined to obtain image *data* and thus the storing of an actual image is contradictory to the image capturing means and is thus indefinite. Likewise, the display means is dictated to display images captured by the image capturing means and again the image capturing means is not defined to capture such images, only image data which can be a number of data parameters and is not definite of an image, but data associated with the image. Further the claim appears to be contradictory as it claims an image capturing means for obtaining data and then later states the method obtains an image of each of the playing cards and it is not understood what exactly the method comprises. A skilled artisan would not be able to ascertain what is required for the method as the claim is repetitive, contradictive and not clearly definite as to what it intends to represent.

Therefore, for examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 12, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding (US Patent No. 4,807,884) viewed collectively with Hill (US Publication 2002/0068635).

Breeding discloses a card shuffling apparatus (Abstract) that has a housing (FIG 1), a card input receptacle located on the housing (FIG 1) adapted to receive at least one deck of unshuffled playing cards and a shuffling device (Abstract). Breeding discloses the shuffler has an output mechanism that is also present for transporting the shuffling deck into a dealing shoe (Abstract). Breeding is silent about what comprises the dealing shoe device. However, Hill discloses the substance that makes up such a dealing shoe in stating that an optimal card dispensing shoe has a controller disposed within (Abstract), an image capturing means (Abstract). Hill also discloses a display system on the shoe to present this information (paragraph 23) and an output bin for the cards (FIG 1).

It would have been obvious to one of ordinary skill in the art to use the shoe disclosed by Hill in the system of Breeding. As the shoe of Breeding only dispenses cards, it lacks the security that is accounted for in the Hill dispenser. Hill discloses that the shoe provides a real-time mechanism for identifying and recording with nearly 100% accuracy the card value, card ranks, card suit, and sequence in which each card was removed or delivered while also

discouraging cheating (paragraph 13 and paragraph 3). Thus one of ordinary skill in the art would be motivated to use the Hill device over the generic dispenser shown in Breeding for the security and recording capabilities as disclosed by Hill.

Regarding claim 2, Hill discloses a control panel on the housing having keys operatively connected to the CPU (FIG 1).

Regarding claim 3, the display means is located on the control panel (FIG 1).

Regarding claim 4, the CPU includes a processor and had a memory to record the cards (paragraph 23) and also has an image processing means (paragraph 23).

Regarding claims 5 and 7, the controller includes software that is executable (paragraph 25, 59, Abstract).

Regarding claim 6, the memory axiomatically has the capacity to store data, as is the defined function of memory in the art.

Regarding claim 8, Hill discloses the display can be a liquid crystal display (paragraph 62).

Regarding the multiple intended usages of the structure as defined in structure claims 1-8, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham,* 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claim dictated by claims 1-8 the combination of Breeding and Hill is capable of being used to shuffle a number of cards for

different games and to display images. Only a difference of a software program executed by the respective processors, if required, would be necessary to display differently or shuffle differently. The structure of the display and the shuffler is already present, thus the limitation would not result in a structural difference, but merely a different usage of the structure already present and thus the recitation that the device be employed in a specific manner regarding the actions of the structure does not differentiate the claimed apparatus from the Breeding/Hill apparatus, which satisfies the claimed structural limitation. Additionally, the Applicant is invited to review MPEP §2114 R-1 which states: MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).* Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)* (emphasis in original).

Regarding method claim 12 (as best possibly understood), it has been disclosed above that the combination of Breeding and Hill provide a card shuffler with a housing, an input located on the housing, and a shuffling device. It is also disclosed that the shoe can be preprogrammed with game rules thus control the barrier to ensure against wrongful dispensing after the cards are shuffled (Hill, Abstract). Thus, the device can be used in at least two different card games with different card distribution and shuffling requirements. The device also includes a controller with a microprocessor and memory for storing data regarding the cards (Hill). The controller also has an image processing and image capturing means as well as a display means and a

card output bin (Hill, paragraph 23). Further, the method of the combination requires the system to receive unshuffled cards in the input receptacle and shuffling the cards in a random order and as established above can handle cards with respect to a number of different game requirements. An image of each card is obtained through the scanner, which recognizes the card and therefore thought processing establishes its image and can subsequently display the information to the display means (Hill, paragraph 23)

Claims 9-11 and 13-16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding (US Patent No. 4,807,884) viewed collectively with Hill (US Publication 2002/0068635) further in view of Hill (US Patent No. 5,722,893).

What Breeding and Hill disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Hill discloses only that the images are scanned in and then later reproduced; however, it is not disclosed that a camera is used to do so.

In an earlier patent, Hill ('893) discusses the different types of devices that can be used in a scanner. Hill ('893) discloses a scanner in a shoe can be any one of a number of different devices including an infrared laser scanner, an optic-sensor, an infrared laser scanner with an OCR, a charged coupling device laser, or a infrared camera that will photograph the images as the card passes over the optical ends of the scanner as it leaves the shoe. In the '635 device Hill uses an OCR to recognize the cards. Based on the earlier disclosure of the number of different types of scanner that are readily available for the system, it would have been obvious to one of ordinary skill in the art to use a camera interface to capture the actual image of the card as opposed to an optical scanner. It is know in the art that OCR is not perfect and thus one would be motivated to use the camera as a design alternative in order to increase the

accuracy of the scanning device relative to the cards recorded. The usage of one type of camera over another would be a design choice capable of being established by one of ordinary skill in the art in order to meet the wants and desires for their system and the designer would be motivated by these specification in choosing which type of camera to use.

Regarding claim 13, it has been disclosed above it would be obvious to use an actual camera to obtain the images instead of OCR, thus an method of compressing image data would be obvious as is known in the art to reduce the storage required. A skilled artisan would thus be motivated to use such compression in order to maximize the data that could be stored in the memory and allow for smaller memory to be required in order to increase efficiently and security while reducing cost.

Regarding claim 14, Hill ('635) discloses the image data is stored for each playing station for a plurality of games.

Regarding claim 15, Hill discloses the display can be a liquid crystal display (paragraph 62).

Regarding claim 16, Hill discloses the image data is displayed including the sequence in which each card was removed thus including multiple card data for multiple stations (paragraph 23).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,659,460: Card shuffler that has a connection to a shoe device for dealing purposes.

US Patent No. 6,582,301: Card dispensing shoe that includes a scanner and CPU for use in a card game.

US Patent No. 6,588,751: Device for shuffling and monitoring cards that are used in a gaming environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks, SPE, can be reached on (703)-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
June 1, 2004

MICHAEL O'NEILL
PRIMARY EXAMINER